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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/816,683	03/23/2001	James Thomas Edward McDonnell	B-4110 618604-0	5208

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HEWLETT PACKARD COMPANY
P O BOX 272400, 3404 E. HARMONY ROAD
INTELLECTUAL PROPERTY ADMINISTRATION
FORT COLLINS, CO 80527-2400

EXAMINER

DADA, BEEMNET W

ART UNIT	PAPER NUMBER
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2135

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/816,683

Applicant(s)

MCDONNELL ET AL.

Examiner

Beemnet W. Dada

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 and 24-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-12, 14, 16-18, 24-28 and 30-31 is/are rejected.
- 7) ☒ Claim(s) 6, 13, 15, 29 and 32 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The request filed on August 08, 2005 for a request for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application 09/816,683 is acceptable and an RCE has been established. Claims 1 and 24 have been amended and claims 19-23 have been cancelled. Claims 1-18 and 24-32 are pending.

Response to Arguments

2. Applicant's arguments filed August 08, 2005 have been fully considered but they are not persuasive. Applicant argued that Pirila (US Patent No. 6,674,860) fails to teach the limitation where "location data is provided in encrypted form by a location server to a recipient". Applicant further argued that Pirila fails to teach the limitation where "a decryption entity that is not under the control of a user of the recipient". Examiner disagrees.

Examiner would point out that Pirila teaches encrypted location data that is relating to the location of the mobile entity is transmitted from a location server to the mobile entity [see for example column 7, lines 25-36]. Examiner would further point out that Pirila further teaches that the encrypted location data is transmitted from the mobile entity to a decryption entity (i.e., smart card of the mobile entity, wherein the smart card is not under the control of the user of the mobile entity, for example see column 4, lines 19-26, **the user of the mobile entity won't be able to falsify the data in the smart card of the mobile entity**) [column 3, line 65 – column 4, line 26]. Examiner asserts that Pirila teaches the claim limitations therefore the rejection is respectfully maintained.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 2135

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-5, 7-12, 14, 16-18, 24-28 and 30- 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Pirila US Patent 6,674,860 B1.

5. As per claims 1, 24 and 31, Pirila teaches a method / arrangement of billing for location data that represents the location of a mobile entity, wherein:

the location data is provided in encrypted form by a location server to a recipient that is one of the mobile entity and a service system for providing a location based service to the mobile entity using said location data as an input [column 7, lines 26-37, column 3, lines 47-66 and column 6, lines 25-61], the location data being encrypted such that it cannot be decrypted by the recipient (i.e., the location data can only be decrypted in the mobile intelligent module (SIM card)) [column 5, lines 19-24 and column 6, lines 57-63], the encrypted location data is subsequently passed by said recipient to a decryption entity that is not under the control of the user of the recipient (note that the user doesn't have control over the intelligent module, see for example column 4, lines 21-26) [column 3, line 65 – column 4, line 26], the decryption entity decrypts the location data and generates a billing record in respect of the location data [column 9, lines 16-17 and column 4, lines 4-27].

6. As per claim 2, Pirila further teaches wherein the encrypted location data is decrypted by the decryption entity with explicit or implicit authorization by the mobile entity [column 4, lines 16-26].

7. As per claims 3, 4, 18 and 25, Pirila further teaches the recipient is a mobile entity and the decryption entity is under the control of location server or an agent of the later [column 6, lines 25-37 and lines 57-63].

8. As per claims 7, 16, 26-28 and 30, Pirila further teaches wherein mobile entity passes the encrypted location data to the decryption entity for decryption and return [column 3, line 65 – column 4, line 26].

9. As per claims 8, 5 and 12, Pirila further teaches the recipient is the mobile entity and the decryption entity is a service system to which the mobile entity passes the encrypted location data in association with a service request [column 3, line 65 – column 4, line 26].

10. As per claim 9, Pirila further teaches wherein the recipient is the mobile entity and the decryption entity is a service system (intelligent module SIM) to which the mobile entity passes the encrypted location data in association with a service request [column 3, line 65 – column 4, line 26].

11. As per claims 10 and 11, Pirila further teaches wherein the recipient is the service system and the decryption entity is under the control of the location server or an agent of the later [column 6, lines 25-37 and lines 57-63].

12. As per claim 14, Pirila further teaches wherein the mobile entity obtains the encrypted location data from the service system and passes it to the decryption entity for decryption and return [column 3, line 65 – column 4, line 26].

13. As per claim 16, Pirila further teaches wherein the service system is a location-data archive system [see for example MLC, figure 3].

14. As per claim 17, Pirila further teaches wherein the recipient is the service system and the decryption entity is the mobile entity, the latter having received the encrypted location data from the service system [column 6, lines 25-37 and lines 57-63].

Allowable Subject Matter

15. Claims 6, 13, 15, 29 and 32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beemnet W. Dada whose telephone number is (571) 272-3847. The examiner can normally be reached on Monday - Friday (9:00 am - 5:30 pm).

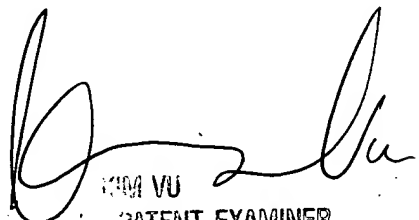
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2135

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Beemnet Dada

October 27, 2005



KIM VU
PATENT EXAMINER
TECHNOLOGY CENTER 2100